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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,894	02/13/2007	Yoshinobu Nakajima	283009US0PCT	2360

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EXAMINER	
MOORE, WALTER A	

ART UNIT	PAPER NUMBER
1794	

NOTIFICATION DATE	DELIVERY MODE
12/21/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/560,894	Applicant(s) NAKAJIMA ET AL.	
	Examiner WALTER MOORE	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

RESPONSE TO AMENDMENT

Acknowledgment of Documents

1. Claims 1-20 are pending. Claim 1 was amended in the response filed on 11/9/2009.
2. Amendments to the specification, filed on 11/09/2009, are accepted.

Withdrawn Objections and Rejections

3. The objection specification made of record in the office action mailed 7/7/2009 is withdrawn due to applicant's amendment filed on 11/9/2009.
4. The 35 USC 112 first paragraph rejections of claims 1-20 made of record in the office action mailed 7/7/2009 is withdrawn due to applicant's amendment filed on 11/9/2009.
5. The 35 USC 112 second paragraph rejections of claims 1-20 made of record in the office action mailed 7/7/2009 is withdrawn due to applicant's amendment filed on 11/9/2009.

REJECTIONS

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

7. Claims 1-5 and 7-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai et al., WO 00/78162 A2, in view of Goto et al., USPN 6,139,897.

Regarding claim 1, Kawai teaches an acidic (pH 2 to 6, col. 3, ln. 10-11) oil-in-water emulsified composition (p. 1, first paragraph), comprising fats (p. 5, ln. 16-19) and oils (p. 4, second paragraph, ln. 3) comprising 30 wt% or more of diglycerides (p. 5, ln. 8-13) and an enzyme-treated yolk (p. 7, third paragraph) treated with one or more enzymes selected from the group consisting of esterase, lipase, and phospholipase (p. 7, third paragraph).

Kawai does not teach the oil-in-water composition comprises an antioxidant at 1200 to 8000 ppm relative to an oil phase containing the fats and oils and at a weight ratio of .85 to 4.5 percent relative to the net weight of yolk in the enzyme-treated yolk.

Goto is drawn to an acidic (col. 6, ln. 24) oil-in-water composition (col. 6, ln. 13) comprising diglycerols (col. 2, ln. 63) and phytosterols (col. 6, ln. 20). Goto teaches adding antioxidant in the range of 50 to 2000 ppm (col. 4, ln. 66-67). Goto teaches adding the antioxidant for the purposes of storage stability and flavor stability (col. 4, ln. 67). It would have been obvious to one of ordinary skill in the art at the time of invention to use an antioxidant, as taught in Goto, in the oil-in-water emulsified composition, taught in Kawai, to obtain an oil-in-water emulsified composition having an antioxidant because the antioxidant improves storage stability and flavor stability (Goto, col. 4, ln. 67).

The examiner notes that adding 2000 ppm of antioxidant, as taught in Goto, to the oil-in-water emulsified composition, taught in Kawai, results in an antioxidant to yolk

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weight ratio of 0.019, which is 1.9%. See Kawai, Table 2, Example 4 (calculation: $[2000 \text{ ppm} * 70 \text{ (oil phase)}] / 7.5 \text{ (10\% salt added yolk)} = 0.019$).

Regarding claims 2, 4, and 8, Kawai teaches the oil-in-water emulsified composition includes an emulsifier such as sorbitan fatty acid ester, polyglycerin fatty acid ester, or sucrose fatty acid ester (p. 6, ln. 16-18).

Regarding claims 5, and 9-13, Kawai teaches the oil-in-water emulsified composition comprises a phytosterol (p. 8, second paragraph).

Regarding claims 3 and 7, Goto teaches the antioxidant is tocopherol and tocotrienol (col. 5, ln. 3).

8. Claims 6 and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai et al., WO 00/78162 A2, in view of Goto et al., USPN 6,139,897, as applied to claims 1-5 and 7-13 above, and further in view of Koike et al., WO 2002/011552.

Kawai in view of Goto is relied on as above. Kawai in view of Goto does not teach an oil-in-water emulsified composition wherein the content of trans-unsaturated fatty acids in the diglyceride is 5% or less.

Koike is drawn to an oil/fat composition having a specific glyceride composition (p. 1, ln. 4-5). Koike teaches a diglyceride with 15 to 90 wt. % of its fatty acid constituents comprising omega 3-unsaturated fatty acids. Specific examples include .alpha.-linolenic acid (all cis-9,12,15-octadecatrienoic acid) and stearidonic acid (all cis-6,9,12,15-octadecatetraenoic acid) (bottom p. 4 to top p. 5). Koike teaches the content of the trans-unsaturated fatty acid is preferably 5% or less for health reasons (p. 5, ln. 17-18). Koike highlights various negative health aspects of trans-unsaturated fatty acids (p.

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2). It would have been obvious to one of ordinary skill in the art at the time of invention to use diglycerides with a trans-unsaturated fatty acid content of less than 5%, as taught in Koike, in the oil-in-water emulsion composition, taught in Kawai in view of Goto, to obtain an the oil-in-water emulsion composition having diglycerides with a trans-unsaturated fatty acid content of less than 5% because diglycerides with 5% and lower trans-unsaturated fatty acids pose less health risks (Koike, p. 2).

Response to Arguments

9. Applicant's arguments filed 11/9/2009 have been fully considered but they are not persuasive.

In response to applicant's argument that neither Kawai nor Goto recognize a problem with respect to aging flavor (Remarks, p. 9, last paragraph to top of p. 10), the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicant argues the combination of Kawai in view of Goto does not teach the claimed ratio of antioxidant to yolk. However, as stated in the rejection Kawai in view of Goto teaches an overlapping range of weight ratio. Examiner cited a single example in Kawai to calculate the ratio. However, each example in Kawai will result in an overlapping ratio. Applicant does not address how the single example, as cited in the office action mailed on 7/7/2009, or any of the other example fails to meet the claimed range.

Applicant argues that the combination of Goto with itself does not result in the claimed invention (Remarks, p. 10, second full paragraph). However, the examiner did not base the rejection on Goto alone. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Additionally, the examiner based the rejection on the closest prior art, i.e. Kawai, in combination with Goto. The Goto reference is used to demonstrate the conventionality of using an antioxidant in mayonnaise composition. The examiner is not relying on Example number 9 to illustrate the claimed invention. Applicant's use of Goto example 9 merely illustrates that various recipes are available to make mayonnaise.

Applicant asserts that the discovery of a problem can result in patentability and cites *Eibel*, 261 US 45. However, applicant fails to explain how the alteration of a Fourdrinier machine in a way that the prior art had not taught, i.e. change to the thickness of a wire, applies to this situation. Here, the prior art recognizes a range of antioxidant as claimed. The properties of the antioxidant, i.e. changes in taste profile, cannot patentably distinguish the claimed invention from the prior art because a chemical composition and its properties are inseparable, MPEP 2112.01 II, and the mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. MPEP 2145 II.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WALTER MOORE whose telephone number is (571) 270-7372. The examiner can normally be reached on Monday-Thursday 9:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/WM/
Walter Moore, Examiner AU 1794
12/15/2009

/Alicia Chevalier/
Primary Examiner, Art Unit 1794